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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/094,719 06/15/98 SLYNE

W 9991-06

024035
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QM12/0815

EXAMINER

TRINH, M

ART UNIT

PAPER NUMBER

3729

DATE MAILED:

08/15/01

AIR MAIL

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

Office Action Summary

Application No.

09/094,719

Applicant(s)

SLYNE, WILLIAM J.

Examiner

Minh Trinh

Art Unit

3729

-- **Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 8-20, 25, 26 and 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 21-24 and 27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's election without traverse of claims 1-7, 21-24 and 27 in Paper No. 16 is acknowledged.

Claims 8-20, 25-26 and 28-30 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups II-IV, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 15.

Applicant reminder that non-elected claims 8-20, 25-26 and 28-30 should be canceled.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7, 21-24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said rotating cylindrical" in line 3. There is insufficient antecedent basis for this limitation in the claim.

The limitation "at least two cutting means" is not a positive method claims as to whether the applicants are intending to claim a method as stated in the preamble, or a cutting apparatus.

The limitation "is disposed" (claim 21), "rotates about" (claim 22), "is in rolling" (claim 22), "moved along" (claim 23), "controlled by" (claim 24), "is wrapped" (claim 27) and many others are not active method steps

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4,512,226 to Juckett in view of US patent 4,725,961 to Pearl.

Juckett teaches the method of cutting pattern pieces including the steps of unrolling the sheet material 42 onto a rotating cylindrical cutting surface 32 (figures 1-5, col. 3, lines 1-10). Juckett meets all aspect of the present invention except for the method of moving the cutting means across the cylindrical cutting surface to cut the material while rotating the cylindrical surface. Pearl teaches a concept of method of moving the cutting means 56 across the cylindrical cutting surface 26 to cut the material while rotating the cylindrical surface 26 (col. 4, lines 45-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize with a method step of cutting across the cylindrical cutting surface as taught by Pearl onto the method of Juckett for various known benefits including cutting pattern material effectively and efficiently. Furthermore, it would have been an obvious matter of design choice to choose any desired number of cutting means since applicant has not disclosed that at least two cutting means solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the teaching of a cutting means taught by Pearl.

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It is noted that the recite limitation in preamble of "at least two cutting means" has not been given weight because it is not effect the method claims.

Regarding claim 2, Pearl teaches a vacuum means (col. 3, lines 55-58).

Limitation of claims 3 is also satisfied in view of above discussion.

Regarding claims 4-5, It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust or independent control the cutter member, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Regarding claims 6-7, It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material such as cutting means is wheel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Limitation of claims 21-23 are also met in view of Pearl's figure 1.

Regarding claim 24, Pearl teaches computer control system operatively associated with the process of cutting as shown in figure 1.

Limitation of claim 27 is clearly defined by Pearl's figure 1.

Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887.

The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

mt

August 13, 2001

Lee Young
8/13/01

LEE YOUNG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.